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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/659,255 | 09/11/2003 | Hisamitsu Takahashi | TAKA3007/EM | 3546 |
| 23364 | 7590 | 09/17/2004 | EXAMINER | |
| BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314 | | | GARRETT, DAWN L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1774 | |

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/659,255 | Applicant(s) TAKAHASHI ET AL. | |
| | Examiner Dawn Garrett | Art Unit 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment dated August 3, 2004. Claims 1 and 2 were amended. Claim 9 was newly added. Claims 1-9 are pending.
2. The rejection of claims 2 and 6-8 under 35 USC 112, second paragraph, set forth in the Office action mailed May 3, 2004, paragraph 3, is withdrawn due to the amendment.
3. The rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Das et al. Journal of Indian Chemistry, 61(8), p. 697-698, (1984) is withdrawn due to the amendment. The R1 and R2 groups are now limited to C4-10 alkyl groups.
4. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Kharitonova et al., Koordinatsionnaya Khimiya, 9(3), p. 319-321, (1983) is withdrawn due to the amendment.
5. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Kralova et al., Monograph Series of the International Conferences on Coordination Chemistry held periodically at Smolenice in Slovakia, 3 (Progress in Coordination and Organometallic Chemistry), p. 233-238, (1997) is withdrawn due to the amendment.
6. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Bhirud et al., Inorganica Chimica Acta, 173, (1990), pages 121-125 is withdrawn due to the amendment.

Claim Objections

7. Claim 1 is objected to because of the following informalities: The text of claim 1 refers to "formula (i)"; however, the actual formula shown uses capital (I). Consistency in naming the formula is suggested. Appropriate correction is required.

Specification

8. The amendment filed August 3, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant has added a general compound formula that is broader than what was previously present in the specification. Formula (I) inserted on page 4 has three "R" groups attached to the nitrogen whereas the previous formula has only two "R" groups attached to the nitrogen. Only specific formulas XIII and X has three "R" groups attached to the nitrogen are supported by the original disclosure. In addition, applicant now claims R_3 - R_8 may be C_1 - C_6 hydroxyalkyl. The only hydroxyalkyl groups supported by the original disclosure are those specifically shown in formulas X and XIII, which do not provide support for a range of the number of carbon atoms as broad as given in the amendment. Also, it is not seen where the original disclosure supports C_3 - C_9 alkenyl groups for groups R_3 - R_8 . Furthermore, with regard to groups R_3 to R_8 forming a condensed aromatic ring with the two nitrogen atoms, only the specific formulas II, VIII, IX, XI, and XII having condensed groups attached to the nitrogen atoms are supported by the original disclosure. In addition, the added "R" groups in the amended paragraph inserted at page 7 are considered to be new matter for the same reasons as described above.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1774

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Support has not been found in the specification for the full scope of amended Formula (I) in claim 1. Formula (I) of claim 1 has three "R" groups attached to the nitrogen whereas the previous formula has only two "R" groups attached to the nitrogen. Only specific formulas XIII and X having three groups attached to the nitrogen are supported by the original disclosure. In addition, applicant now claims R₃-R₈ may be C₁₋₆ hydroxyalkyl. The only hydroxyalkyl groups supported by the original disclosure are those specifically shown in formulas X and XIII, which do not provide support for a range of the number of carbon atoms as broad as given in the amendment. Also, it is not seen where the original disclosure supports C₃-C₉ alkenyl groups for groups R₃-R₈. Furthermore, with regard to groups R₃ to R₈ forming a condensed aromatic ring with the two nitrogen atoms, only the specific formulas II, VIII, IX, XI, and XII having condensed groups attached to the nitrogen atoms are supported by the original disclosure.

Response to Arguments

11. Applicant's arguments filed August 3, 2004 have been fully considered but they are not persuasive.

Applicant states "Applicants most respectfully submit that the detailed amendments to the specification and claims are fully supported by the application as originally filed as would be appreciated by one of ordinary skill in the art to which the invention pertains. In this regard, please note that the amendment to claim 1 and the corresponding amendments in the specification correct obvious errors which would be fully appreciated by one of ordinary skill in the art to which the invention pertains." The examiner has carefully considered the passages and formulas cited by applicant as providing support for the amendment. The examiner has concluded that the specification as originally filed as well as the foreign priority document do not provide support for the compound as currently claimed. The examiner does note that the very specific example compounds do fall within the scope of the currently claimed compound and these particular compounds are supported by the specification. These few example compounds do not provide full support for all the substituent possibilities set forth in broadly claimed formula (I).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is 571-272-1523. The examiner can normally be reached Monday through Friday during normal business hours. Please allow the examiner twenty-four hours to return your call.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dawn Garrett
Primary Examiner
Art Unit 1774

D.G.
September 15, 2004